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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,447	09/24/2003	Joseph M. Mullins	BEC 01908 C4US	4584
32233	7590	03/29/2004	EXAMINER	
STORM & HEMINGWAY, L.L.P. 8117 PRESTON RD. STE. 460 DALLAS, TX 75225			CAPUTO, LISA M	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,447

Applicant(s)

MULLINS ET AL.

Examiner

Lisa M Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 032104.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

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Double Patenting

1. Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,142,368 to Mullins et al. (from hereinafter "Mullins").

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-30 of the instant application, the applicant claims a transaction system and method that comprises a plurality of articles, more specifically wristbands, that are attachable to a user and are usable for financial transactions wherein a computerized accounting system maintains an account associated with each article and is programmed to accept a monetary value of a transaction for arithmetically adjusting a balance maintained in the accounting system. The Mullins patent discloses a transaction system and method that utilizes articles usable in lieu of money, more specifically wristbands, that are attachable to a user and are usable for financial transactions wherein a computerized accounting system is programmed to accept a monetary value of a transaction for arithmetically adjusting a balance maintained in the accounting system and to accept a monetary value to be credited to the account, and further, that the accounting system being programmed to respond to a purchase transaction for only a specified period of time after issuance of article to a user.

Although the scope of claims 1-30 of the present application and claims 1-35 of the Mullins patent are very similar, the difference between the present claimed invention and the Mullins patent is that the present claimed invention is a broader recitation of the

Mullins patent (i.e. the present claimed invention does not recite the multitude of additional limitations of the time constraints placed on the usability of the articles and the subsequent debiting thereof). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-35 of the Mullins patent as a general teaching for the transaction system and method as recited by the present application.

The nonstatutory obviousness-type double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Newman et al. (U.S. Patent No. 6,349,493, from hereinafter Newman).

Newman teaches debit wristbands. Newman discloses a transaction system and method comprising a plurality of articles, each being attachable to a user in such a manner that the article cannot be removed and a computerized accounting system maintaining an account associated with each said article, said system programmed to accept said identification of an article and accept in association therewith a monetary value of the transaction involving the article bearing the identification, for arithmetically adjusting a balance maintained in the accounting system in association with article identification as recited in independent claims 1, 4, 19, and 26, and their dependent claims. For example, an exemplary wristband according to the present invention is shown generally by reference numeral 10 in FIGS. 1-4. The wristband 10 is designed for use for a short period of time in an amusement park environment where it is likely to be exposed to water that is chemically treated (e.g. chlorine and bromine) and perspiration. The main elements of the wristband 10 comprise a strip of a first material 11 (see FIGS. 2 & 3), bar coding shown generally by reference numeral 12 (see FIGS. 1, 3 and 4), a waterproof covering shown generally by reference numeral 13 (see FIGS. 1 & 3), and attachment means 14 (see FIGS. 1, 2, and 4) for attaching the wristband 10 to a patron's wrist, as illustrated in FIG. 4. The strip 11 of a first material--preferably a waterproof paper--has first and second faces 15, 16 respectively (see FIG. 3), and is capable of having indicia imaged on the first face 15 thereof. The material of the strip 11 is tear resistant but will tear completely if subjected to a force which would jeopardize

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the safety of the wearer in an amusement park environment if it did not tear; and it has first and second ends 17, 18 (FIGS. 1 and 4), the first and second ends 17, 18 being spaced from each other along the length of the strip 11, and the strip 11 having its length dimension greater than its width dimension, as clearly seen in FIG. 1. The length dimension is sufficient to wrap the wristband 10 once around the wrist of a human without substantial excess material, as seen in FIG. 4. Different sizes/lengths of wristbands 11 may be provided to accommodate patrons of significantly different wrist size. One ideal material for the strip 11 is eight point KIMDURA waterproof paper available from Kimberly Clark, initially provided in continuous web form. The bar code indicia 12 imaged on the strip first face 15 may be imaged using an ion deposition printer, or in other conventional manners. Preferably the indicia 12 is base thirty-six bar code. This code is a small, though readily readable, size code which allows the width of the wristband 10 to be minimized, and allows room for graphics, instructions, or other indicia on other portions of the face 15. As seen in FIG. 1, preferably two distinct, spaced, bar code groups 12 are provided.

Further, an amusement park is shown schematically in FIG. 6. At the park the wristbands 10 may be sold at the entrance or locker room building 41, the correct amount being applied thereto as is conventional for debit card systems which use bar coding, and the release paper 26 removed and the adhesive 25 attached to the top face 15 (or coating 13 thereon) of the strip 11 at the second end 18 thereof, as seen in FIG. 4. The bar coding can be read at numerous locations within the park, for the purchase of goods or services, scanners 42 being provided at food concessions or restaurants

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43, souvenir booths 44, arcades 45, rides 46, and/or shows 47, as well as all other conventional facilities in amusement parks. Exactly where the scanners 42 are used will depend upon what facilities within the park are included in the price of admission (e.g. most rides and shows at some parks, but few or none at others), a scanner 42 being provided at each facility or exhibit at which cash or credit cards would normally be needed by a patron. (see Figures 1-6, col 3 line 66 to col 6 line 60).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,388,612 to Neher which teaches a global cellular position tracking device.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**lisa.caputo@uspto.gov**].

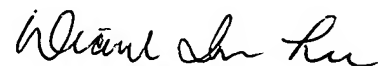
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



LMC

March 21, 2004



DIANE I. LEE
PRIMARY EXAMINER